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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,006	11/28/2001	Paul L. Master	021202-000300US	3894
37490	7590	07/26/2005	EXAMINER	
CARPENTER & KULAS, LLP 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303			DYKE, KERRI M	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,006	Applicant(s) MASTER ET AL.	
	Examiner Kerri M. Dyke	Art Unit 2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 11, 12 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because:
 - a. Figure 1 has no element numbers as described in the specification.
 - b. The element numbers for Figure 2 do not match the element numbers used in the specification.
 - c. Element number 120 is used to refer to both the “original manufacturer” and “device.”

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 needs to be reworded. A system needs some structural component and

Art Unit: 2667

cannot consist solely of operating instructions. It is also unclear how the digital processing system, communication link, and adaptable device are connected together. It is unclear whether “the system” in line 4 refers to the “system” of line 1 or the “digital processing system” of line 3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (US 5,335, 276).

In regards to claim 1, Thompson et al. discloses a method for authorizing the use of an adaptable device, the method comprising detecting that the adaptable device is adapted to perform a first type of operation at a first point in time; detecting that the adaptable device is adapted to perform a second type of operation at a second point in time (Figure 2 element 50 which can operate as a cellular or cordless telephone as explained in column 3 lines 59-65); and using the detected adaptations to determine whether to authorize the continued use of the device (Column 18 lines 52-57). Thompson et al. explains that voice authentication can be used to prohibit operation of the device or just one adaptation of the device.

In regards to claim 2, Thompson et al. discloses the method of claim 1, wherein the first and second types of operation are cellular telephone operations. Figure 2 element 50 shows the hand-held communication device in the general shape of a cellular telephone (column 7 lines 44-

Art Unit: 2667

45). Figure 8 element 90 shows the wireless communication circuit which provides standard cellular communication as described in column 13 lines 61-62.

In regards to claim 8, Thompson et al. discloses the method of claim 1, wherein the detecting steps include the substep of receiving usage information from the device (column 18 lines 41-45). In this case the usage information being sent is the fact that the device is being operated as a cellular telephone.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Gateway Solo 9300 laptop computer offered for sale on March 3, 2000.

Claim 1 is so broad that it reads on many readily available devices, such as a laptop computer. This Gateway model is offered as a representative of the type available on the open market before invention of the claimed subject matter.

In regards to claim 1, Gateway discloses a device that is adaptable using modular drives. The computer detection of which drives are currently connected will determine the continued capabilities of the laptop.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 5,335,276) in view of Pitman et al. (US 6,748,360).

Thompson et al. discloses the method of claim 1, (see 102 rejection above). It does not disclose that the device can be used as a media player, but it would have been obvious that the application modules (Figure 10) could have been used to provide media player functions to the adaptable device.

Pitman et al. discloses a device (Figure 1 element 112) capable of at least two different types of media player operations (column 4 lines 6-7). In this case the device is a content player capable of outputting audio in a plurality of formats including MIDI, WAV, and MP3.

It would have been obvious to a person of ordinary skill in the art to add the ability to play music of different formats as taught by Pitman et al. to the adapted device as taught by Thompson et al.

The motivation for combining the devices is provided in column 6 lines 11-16 of Pitman et al. The user can use Thompson et al.'s device to connect to music vendors. There they can identify and purchase songs, regardless of format, as described by Pitman et al.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson et al. (US 5,335, 276) in view of Urban et al. (US 5,630, 206).

Thompson et al. discloses the method of claim 1, (see 102 rejection above), but does not disclose the first and second types of operation are global position satellite (GPS) receiver types of operations.

Urban et al. discloses a cellular telephone (Figure 1 element 10) with a GPS receiver (Figure 1 element 12A).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add the GPS capability of Urban et al. to the adaptable device of Thompson et al.

Art Unit: 2667

The motivation for doing so would be to obtain services such as emergency roadside assistance or personal emergency response as disclosed by Urban et al. in column 1 lines 15-21.

10. Claims 3, 6, 7, 9, 15, and 16 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Thompson et al. (US 5, 335, 276)

In regards to claim 3, Thompson et al. discloses the method of claim 2, wherein the first and second types of operation are each one of the following: analog cellular telephone or radio frequency transmission (column 13 lines 62-63). In column 17 lines 12-24 Thompson et al. discloses that the adaptable device can be configured to use any communication protocol. Thompson teaches in column 17 lines 21-23 that the application module 100 can simply be replaced when protocols were changed or new ones were developed. It would have been obvious to a person of ordinary skill in the art to use the application module to configure the adaptable device to use the TDMA and CDMA protocols because they were, and continue to be, commonly used protocols.

In regards to claim 6, Thompson et al. discloses the method of claim 1, and the substep of transferring information about the operation of the device to an entity located remotely from the device (column 2 lines 60-63 and column 4 line 10). Thompson does not disclose the use of the Internet, but it would have been obvious to one of ordinary skill in the art to use the Internet for high speed, digital transfer of the information. The Internet was in its infancy at the time Thompson et al. filed their invention but it seems clear that they intended their device to be able to use all available communication networks. The inclusion of a modem, as indicated in column 4 line 34 also suggests that Thompson et al. intended for their device to transfer information using the Internet.

In regards to claim 7, Thompson et al. discloses the method of claim 1, wherein the detecting steps include the substep of transferring information about the operation of the device to an entity located remotely from the device (column 17 lines 55-56). Using the cellular telephone network to transfer the information is not disclosed. Although use of the cellular telephone network is not stated explicitly, it would have been obvious to one of ordinary skill in the art to use the cellular telephone network since one of the primary embodiments of the invention is an adaptable cellular telephone.

In regards to claim 9, Thompson et al. discloses the method of claim 8, but not wherein the usage information includes information about times that the device has been used. Cellular phones are commonly equipped with options that allow the owner to receive information about device usage, such as the number of calls made from the handset, total time of calls, and total time of received calls. It would have been obvious to one of ordinary skill in the art to include this type of information with the Thompson device. If billing was based on usage information such as number of calls made or airtime, as is common, then the consumer would have found it advantageous to know that information.

In regards to claim 15, Thompson et al. discloses a method for tracking the use of an adaptable device at a central site (Figure 1 element 22), the method comprising obtaining information about the changing functionality of the adaptable device; and transferring the information to a central site. Although it is not explicitly stated that information about functionality is sent to the central facility this is an inherent feature. It is explained in column 7 lines 17-19 that the adaptable devices receive information from the central facility. It would have been obvious to one of ordinary skill in the art that in order for information to be received

Art Unit: 2667

the central facility must have some knowledge of the functionality of the adaptable device, especially for use of the subscription services like Dow Jones News Retrieval that are described in column 9 lines 26-36.

In regards to claim 16, Thompson et al. discloses a system for tracking the use of an adaptable device at a central site (It is inherent that there must be some tracking method in order to correctly bill for subscription services), the system executing on a digital processing system (Figure 7 element 76) coupled to a communication link (Figure 7 element 64), wherein the digital processing system executes instructions, the communication link coupled to the adaptable device, the system comprising one or more instructions for obtaining information about the changing functionality of the adaptable device; and one or more instructions for using the information to regulate the use of the adaptable device (column 17 lines 62-63). Both the digital processing system and the central facility keep a copy of the voice recognition template (column 18 lines 50-52) that is used to authorize use. It would have been obvious to one of ordinary skill in the art that the central facility had some authorization mechanism in order to deny access to subscription services like those described in column 9 lines 26-36.

11. Claims 8, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Gateway Solo 9300 laptop computer offered for sale on March 3, 2000.

See the 102 rejection of base claim 1 above.

In regards to claims 8, 10, 13, and 14, it is well known that laptop computers are equipped with several different usage reports including resources, such as hard drive or memory use (accessed through the "My Computer" icon of a Windows computer) and battery or energy consumption (commonly found on the right side of the task bar on a Windows computer). In

Art Unit: 2667

addition, pressing the ctrl, alt, and del buttons at the same time on a Windows computer will display the Task Manager report. The report shows information about the programs currently running and CPU usage. It would have been obvious to a person of ordinary skill in the art to include these reports because they are useful in letting the consumer know when more resources, such as the purchase of additional memory or a recharge, are needed.

Allowable Subject Matter

12. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Coons et al. US 6,832,250, which discloses that it is known to communicate usage data to a central facility using the cellular communication network. Coons also discloses an invention that will allow for billing based upon resource usage.
- b. Sharma et al. US 6,766,165, which discloses an invention that allows for remote management of a "network asset." The asset provides real-time connection and configuration data to the remote entity, which is capable of reconfiguring the asset.
- c. Yamashita US 6,807,435, which discloses a device capable of using either of two radio communication sections. The choice of section depends upon a judging section, which can forbid one of the sections from sending and receiving information.

Art Unit: 2667


- d. Peters et al. US 5,884,284, which discloses a system for tracking and billing usage of available telecommunications services.
- e. Kung US 6,718,182, which discloses an adaptable cell phone.
- f. Lewis et al. US 6,192, 255, which discloses an adaptable cell phone.
- g. Freund US 5,987,611, which discloses a system and method for allowing the use of and monitoring an application, within an adaptable device, access to the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kerri M. Dyke whose telephone number is (571) 272-0542. The examiner can normally be reached on Monday through Friday, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMD


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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2667 7/12/05